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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,007	02/08/2005	Stefan Koller	HM/15-22735/PCT	9480

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EXAMINER
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HOLLOMAN, NANNETTE

ART UNIT	PAPER NUMBER
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1612

NOTIFICATION DATE	DELIVERY MODE
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06/11/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/524,007	<b>Applicant(s)</b> KOLLER ET AL.	
	<b>Examiner</b> NANNETTE HOLLOMAN	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-11 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to the Request for Continued Examination filed on February 27, 2009. Applicants' arguments, filed February 27, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: a closed parenthesis should follow the "step a" in step b) (i.e., "a)") and "step c" in step d). Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102 (Previous Rejection)***

Claims 1, 3-6 and 9-11 were rejected under 35 U.S.C. 102(b) as being anticipated by Struillou et al. (EP0771785). This rejection is maintained.

#### ***Applicant's Arguments***

Applicant argues there is no mention of a reaction of a halo ester with a heterocyclic aromatic amine to produce a water soluble ester involving a reaction at the aromatic amino nitrogen. Applicant further argues that while Struillou discloses reacting the halo ester with an amine to form a salt, Struillou does not disclose the amines of the instant invention.

Examiner's Response

In regard to the reaction of a halo ester with a heterocyclic aromatic amine to produce a water soluble ester involving a reaction at the aromatic amino nitrogen, Struillou et al. disclose the same reaction with the same conditions as claimed. Struillou et al. disclose quaternisation of a tertiary amine with the halogenoacetate ester, wherein the amine is pyridine; the heterocyclic aromatic amine of instant claims 1 and 9-10, and salts are formed (p. 43, line 39 to p. 44, line 40). It would be inherent that the same reaction with the same reagents would form the same product. Applicant's claims do not recite the actual mechanistic steps of the reaction as argued on p. 5, and therefore the reference does not have to disclose the argued mechanistic steps.

***Claim Rejections - 35 USC § 103 (New Rejection)***

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Struillou et al. (EP0771785, as previously disclosed) as applied to claims 1-6 and 9-11 above, in view of Green et al. (US Patent No. 4,026,945).

The primary reference is discussed in detail in the previous office action filed April 02, 2008 and differs from the instant claims insofar as it does not disclose a diamine containing at least one tertiary amino group of instant claim 7.

Green et al. disclose an anti-microbial quaternary ammonium (Abstract). Green et al. disclose a composition comprising N, N, N',-N'-tetramethyl ethylenediamine, which is a synonym for 1,2-bis(dimethylamino)ethane<sup>1</sup>, as an effective microbiocide (column 2, lines 20-23, and claim 1). Green et al. differs from the instant claims insofar as it

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<sup>1</sup> Material Safety Data Sheet (previously disclosed), printed 02/05/2004, section 2-Composition/information on Ingredient, Formula synonyms, compounds 1 and 6. This reference is used to show the formula synonyms and is not relied upon for the basis of the rejection.

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does not disclose a method for the controlled release of a biologically active hydroxyl group.

It is *prima facie* obviousness to select a known material based on its suitability for its intended use. Also, established precedent holds that it is generally obvious to add known ingredients to known compositions with the expectation of obtaining their known function. MPEP 2144.07. Therefore, it would have been obvious to have used the N, N, N',-N'-tetramethyl ethylenediamine in the composition of Struillou et al. motivated by the desire to use a substance with known antimicrobial activity as disclosed by Green et al.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANNETTE HOLLOMAN whose telephone number is (571) 270-5231. The examiner can normally be reached on Mon-Fri 800am-500pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H./

Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612